



PATENT

15
January 14, 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Tsao et al.
Serial No. 09/909,317
Filed: July 18, 2001
For: GENETIC MARKER TEST FOR LUPUS
Examiner: -- Unit: --

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PETITION FOR REVIVAL OF PATENT
APPLICATION UNDER 37 C.F.R. § 1.137(b)

Mail Stop Petition
Commissioner for Patents
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Attention: Office of Petitions

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
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ON January 14, 2004

ANN WEISS

1/14/04
Date of Signature

Dear Sir/Madam:

Petitioner, Cedars-Sinai Medical Center, hereby requests that the above patent application be revived under 37 C.F.R. 1.137(b), which states in relevant part:

(b) Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application. . . A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. . .

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Petitioner submits that the lack of submission of a response to the *Notice to File Missing Parts*, mailed on September 19, 2001, within the period for reply was unintentional, as required by 37 C.F.R. § 1.137(b). As set forth in detail hereinbelow, the delay in submitting a timely

response to the September 19, 2001 *Notice to File Missing Parts* was unintentional, as result of erroneous failure by a later-terminated employee of Petitioner's attorney to properly docket a timely response and to notify Petitioner's attorney that the *Notice to File Missing Parts* had been received. Petitioner's undersigned attorney discovered the existence of the *Notice to File Missing Parts* and the technical abandonment of the above-captioned application only after a routine status check. A telephonic or written *Notice of Abandonment* regarding same had not been issued by the United States Patent and Trademark Office ("USPTO").

I. PERTINENT FACTS

Petitioner filed the above-captioned application on July 18, 2001, with missing parts. Although the filing fee and a sequence listing accompanied the application, the Inventor Declarations of named inventors Betty P. Tsao, Rita M. Cantor, and Jerome I. Rotter were lacking.

Records available to Petitioner's attorney indicate that a *Notice to File Missing Parts* was issued by the USPTO on September 19, 2001. The *Notice to File Missing Parts* was apparently placed in the relevant file wrapper in the offices of Sidley Austin Brown & Wood LLP by Mr. Larry Gordon. Mr. Gordon was a Legal Assistant at Sidley Austin Brown & Wood LLP, who was responsible for processing mail received from the USPTO during the period from approximately November 15, 2000 to approximately April 1, 2002. Unfortunately, Mr. Gordon failed to timely calendar a response to the *Notice to File Missing Parts* and failed to alert Petitioner's undersigned attorney, or any other attorney, as to the receipt of the *Notice to File Missing Parts*, by the transmission of an e-mail alert, as would be the normal and customary practice in the offices of Petitioner's attorney. One might speculate that Mr. Gordon's failure to carry out his customary duties with respect to the *Notice to File Missing Parts* could have had something to do with an extraordinary state of anxiety and distraction during the period immediately following the events of September 11, 2001. Regardless, after the termination of Mr. Gordon's employment by Petitioner's attorney on October 29, 2003, Mr. Gordon's replacement, Ms. Christina Tong, discovered that Mr. Gordon had eventually prepared a draft e-mail alert concerning the *Notice to File Missing Parts* to Petitioner's undersigned attorney on June 11, 2002 (nearly seven months after the due date for response), but that Mr. Gordon had completely failed to transmit the alert to any other person (see Declaration of Christina Tong, appended as **Exhibit A** and its appended **Exhibit 1**).

Consequently, Petitioner's attorney was uninformed of the receipt of the *Notice to File Missing Parts*, until Petitioner's undersigned attorney, who was alarmed by the apparent undue length of time without receipt of a communication from the USPTO, ordered a routine status check in the USPTO by his assistant Ms. Ann Weiss.

On or about Monday, November 3, 2003, Ms. Weiss telephoned USPTO Customer Service to inquire as to the status of the above-captioned application. She was informed that the above-captioned application had officially gone abandoned on October 13, 2003, although she was also informed that a *Notice of Abandonment* had not been issued.

Upon learning of these facts, Petitioner's undersigned attorney had the necessary unexecuted Inventor Declarations prepared, and on November 7, 2003, they were mailed for execution directly to the homes of Drs. Betty P. Tsao and Rita M. Cantor, and to Dr. Jerome I. Rotter in care of Cedars-Sinai Medical Center's Department of Legal Affairs. After Petitioner's undersigned attorney made repeated inquiries over the following two months

concerning the execution of the Inventor Declarations by the three co-inventors; he finally received the last of the three executed Inventor Declarations for filing, that of Dr. Rita M. Cantor, on January 13, 2004. The approximately two months required to assemble all the needed executed Inventor Declarations resulted by no means from a lack of due diligence by Petitioner. Dr. Cantor told Petitioner's undersigned attorney on December 30, 2003 that she had returned from an extended stay in Europe just at the end of December, and thus had been unaware of and unable to attend to the Inventor Declaration that had arrived at her home in her absence. Upon receipt of Dr. Cantor's executed Declaration, on January 13, 2004, Petitioner's undersigned attorney immediately prepared and submitted this petition to revive the above-captioned application, along with the necessary response to *Notice to File Missing Parts*.

II. RELIEF SOUGHT AND CONCLUSION

Petitioner submits that it has adequately shown that the failure to timely respond to the *Notice to File Missing Parts* was entirely unintentional, and was as a result of human error. This human error was by no fault of the Petitioner itself and should not be permitted to prejudice the rights of the Petitioner. As soon as Petitioner's undersigned attorney became aware of the above-recited facts, he promptly prepared and filed this petition along with a response to the *Notice to File Missing Parts*, which is filed herewith. Therefore, Petitioner respectfully requests that its petition to revive the above-captioned application be granted.

The Commissioner is hereby authorized to charge the petition fee under 37 C.F.R. § 1.17(m) of \$665.00 (small entity rate) and any other fees required in the processing of this petition or the consideration of Petitioner's response to *Notice to File Missing Parts*, submitted herewith, or to credit any overpayment, to Deposit Account No. 50-1597.

Respectfully submitted,



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